UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,293	08/11/2000	Guy L. McClung III	GLM III CIP 2	8572

7590 04/02/2004	EXAMINER
Guy McClung	ALVAREZ, RAQUEL
Pmb 347	
16690 Champion Forest Drive	ART UNIT / PAPER NUMBER
Spring, TX 77379-7023	3622

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/637,293	MCCLUNG, GUY L.
	Examiner	Art Unit	
	Raquel Alvarez	3622	MW

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 January 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *24-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *24-36* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to communication filed on 1/13/2004.

2.   Claims 24-36 are newly added and presented for examination.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification doesn't explain how the second vendor is alerted that the first vendor is offering the item or service at a lower price (i.e. better price).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Bloomberg et al. (5,642,279 hereinafter Bloomberg).

With respect to claim 36, Bloomberg teaches a biller computing unit of a vendor,

a consumer location of a vendor at a first time seeking to purchase an item at a first

price (Abstract). Operatively linking the biller computing unit to the network (i.e. two or

more computer can be linked together by a network, a vendor computer such as a point

of sale device where an invoice for the goods sold are created and a main

processor)(col. 3, lines 29-34); monitoring in real time over the network competitors'

sales prices of the item or service at the time and comparing the first price to said

competitors' sales prices and determining if any of said competitors' sales prices is a

second price less than the first price (col. 4, lines 35-47); upon determining that such a

second price exists, generating a bill for the consumer for an amount equal to the

second price at the vendor's location at the time of purchase of the item or service (i.e.

when the competitor's price is lower than the vendor's price then the second price or

lower price will be stored in lieu of the vendor's price and the lower price will be offered

to the customers at the point of sale)(col. 4, lines 39-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomberg et al. in view of Hogan further in view of Walker et al,(6,249,772 hereinafter Walker).**

With respect to claims 24-27, 31, and 33-34 Bloomberg teaches storing payment related to a first transaction in which a consumer pays a first vendor for an item or service, said payment comprising a first price paid by the consumer in the first transaction (i.e. the system stores information on the purchased items)(see Figure 2, item 30); guaranteeing a best price to the consumer for the item or service that are subject to the first transaction (i.e. the system provides price protection to the consumers by refunding the consumer if an item has been advertised at a sale price (col. 1, lines 54-, col. 2, lines 1-35) ; recording the first price and information identifying the consumer (col. 3, lines 50-57); monitoring sales prices of the item or service for a predetermined time period after the purchase of the item by the consumer in the consummated final first transaction (col. 3, lines 62-, col. 4, lines 1-26); noting any sales price lower than the first price during the predetermined time period (col. 3, lines 62-, col. 4, lines 1-26); calculating a money-value difference between the first price and said any price lower than the first price and refunding to the consumer an amount equal to the money value difference (Figure 2).

Bloomberg does not specifically teach the bill payment remittance information being arranged within a data structure having one or more data fields that hold data that the consumer cannot alter, the remittance information further including structured remittance data that is kept hidden from the consumer. On the other hand, Hogan

teaches system and method for bill delivery and payment over a communications

network. The payment remittance information being arranged within a data structure

according to a format prescribed by the biller, the data structure having one or more

open data fields to hold data that a consumer can supply or alter and one or more

closed data fields that hold data that the consumer cannot alter, the remittance

information further including structured remittance data that is kept hidden from the

consumer (i.e. the internal remittance structure is formatted according to the individual

biller's system, some of the data structure not being able to be changed such as the

account number, next reading date and service to and some of the data can be alter

such as the amount paid)(see Figure 4); presenting the bill to the consumer without

revealing the structured remittance data (i.e. the individual's billers internal remittance

information is not displayed to the client)(see figure 4); enabling the consumer to specify

payment instructions including at least one of an amount to be paid on the bill, a

payment date, and an account from which to draw payment, while prohibiting the

consumer from altering data contained in the closed data fields (see Figure 4);

associating the payment instructions with the structured remittance data(col. 8, lines 33-

62); electronically transmitting the payment instructions to initiate payment of the bill

(col. 8, lines 33-62); electronically routing the payment remittance information, including

the structured remittance data, in the biller prescribed format to the biller so that the

structured remittance data is automatically returned to the biller without intervention by

the consumer (col. 8, lines 36-62). It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to have included in the system of

Bloomberg the teachings of Hogan of presenting bill remittance information structured

with the specifics of Hogan because such a modification would allow the system of

Hogan to have the flexibility of providing bills that can be paid at a later time rather than

paying for the transaction at the point of sale.

With respect to the system providing a refund by crediting an account of the

consumer. Bloomberg teaches printing a check to the consumer (see figure 2 of

Bloomberg). Bloomberg does not specifically teach crediting an account of the

consumer. Walker teaches a system for providing the refund by crediting an account of

the consumer (col. 22, lines 17-33). It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to included in the combination of

Hogan and Bloomberg of crediting an account of the consumer because such a

modification would allow the system to immediately provide the refund rather than

having to wait for the refund to be mailed.

With respect to claim 28, Bloomberg further teaches notifying the consumer of

the refund amount (i.e. the consumer receives an envelope with the check notifying the

amount of the check)(col. 6, lines 19-30).

Claim 29 further recites alerting a second vendor that the first vendor is offering

the item or service at a lower price. Official notice is taken that it is old and well known

in marketing for vendors to publish such as in newspapers, website, radio or the like,

their sales prices in order to inform the public including their competitors of their sales.

It would have been obvious to a person of ordinary skill in the art at the time of

Applicant's invention to have included alerting a second vendor that the first vendor is

offering the item or service at a lower price in order to let the competitor know than the vendor is having a sale.

With respect to claim 30, Bloomberg further teaches monitoring all providers' sales prices of the item within a specified geographic area (Figure 2, item 32).

With respect to claim 32, the limitations was previously addressed in the rejection to claims 24-27, 31, and 33-34 and therefore rejected under similar rationale.

Claim 35 further recites transmitting the notification of the refund amount to the consumer computing unit. Bloomberg teaches notifying the consumer of the refund amount by mail (col. 6, lines 19-30). Bloomberg does not specifically teach sending the notification to a consumer computing unit. Official notice is taken that it is old and well known in the computer related arts to send notifications through e-mail or the like in order to speed up receipt. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the notification of the refund amount to the consumer computing unit in order to obtain the above mentioned advantage.

Response to Arguments

7.   The 112 2nd rejection has been withdrawn based on the amendments to the claims.

8.   The 112, 1st rejection has been withdrawn, the pages of the specification specified by the Applicant provides support for the bill payment system guaranteeing a price.

9.   A new 112, 1st rejection has been introduced with respect to the new matter of

newly added claim 29.

10.   In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

11.   Applicant argues that the combination of Bloomberg and Hogan doesn't teach

refunding an amount to a consumer account. The Examiner wants to point out that

Bloomberg was cited for refunding an amount to the consumer (see Figure 2) and that

crediting an account of the consumer is taught by walker on col. 22, lines 17-33).

12.   Applicant argues that Hogan has no teachings or suggestion of guaranteeing a

best price. The Examiner wants to point out that Hogan wasn't cited to teach

guaranteeing a best price. Bloomberg was the reference cited for guaranteeing a best

price (i.e. *"Technique for utilizing a computer system to provide price protection to retail*

customers")(see title).

13.   Applicant argues that Hogan has no teachings of prices going into effect after a

transaction is consummated and no teachings for post-sale monitoring of prices. The

Applicant is reminded that Hogan **wasn't cited for teaching** monitoring the sales of

price of the item after purchase of the item. Hogan was merely cited for the format of

the payment remittance structure. In the other hand, Bloomberg was cited and clearly

teaches **"technique for utilizing a computer system to provide price protection to**

retail customer" (Bloomberg's title). In Bloomberg the price is monitored after the sale

in order to note if the price if there is a lower price than the price that the consumer has

paid in order to refund the customer with the difference in price between the price paid

for the item and the new advertised price (in Bloomberg Figure 2 and col. 3, lines 62-,

col. 4, lines 1-26).

14.   The Applicant is reminded that Bloomberg was the reference cited for teaching

generating a refund based on post-sale activity and that the refund is after a sale has

been completed. In Bloomberg the price is monitored after the sale in order to note if the

price if there is a lower price than the price that the consumer has paid in order to

refund the customer with the difference in price between the price paid for the item and

the new advertised price (in Bloomberg Figure 2 and col. 3, lines 62-, col. 4, lines 1-26).

15.   The Applicant is reminded that the Walker reference was merely cited for

teaching crediting an account of the consumer. Walker on col. 22, lines 17-33 clearly

teaches that a refund can be credited to a customer's credit card account and therefore

crediting an account versus mailing a check will save mailing time and also it will cost

down cost.

16.   In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the skilled in the

art is presumed to have knowledge in the art. Crediting an account of the consumer in

order to save mailing time and cost would flow naturally from following the suggestion of

the prior art and cannot be the basis for patentability when the differences would

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter.

1985).

17.   Applicant argues that there is no motivation in the real world of business to

provide a refund quicker than necessary. The Examiner respectfully disagrees with

Applicant because by providing a refund quicker to a consumer, it would make business

sense because it would facilitate the use of the refunds or rebates to the customers and

therefore would motivate the customers to patronage the establishment which would

result in bigger business's profits. The Examiner wants to point out that Walker doesn't

teach away from the invention because Walker clearly teaches facilitating the sale of

products and avoiding the problem of inconvenience to the consumers (col. 2, lines 32-

37). Therefore by crediting the rebate or refund to the account of the customer would

avoid the problem of inconvenience to the consumers (In walker col. 2, lines 32-37).

18.   In light of the above, it is the Examiner's position that Bloomberg in combination

with Hogan and Walker teach the claimed limitations.

Conclusion

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the date of this final action.

Point of contact

20.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Raquel Alvarez whose telephone number is (703)305-
0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number
for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).
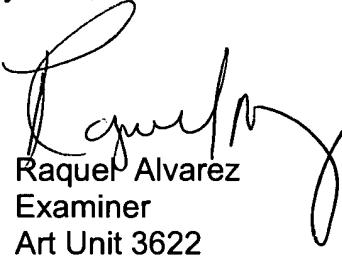
Raquel Alvarez
Examiner
Art Unit 3622

R.A.
4/1/04